Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD J. DICHTEL

Appeal No. 96-1868
Application No. 08/179,443[1]

ON BRIEF

Before CALVERT, MEISTER, and ABRAMS, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 26, which constituted all of the claims of record in the application. Subsequent to the final

[1] Application for patent filed January 10, 1994.

rejection, in response to an amendment, the examiner indicated that claims 16 through 21 were allowed (Paper No. 12), and in the Examiner's Answer claim 11 was indicated as containing allowable subject matter. Therefore, claims 1 through 10, 12 through 15 and 22 through 26 are before us on appeal.

The appellant's invention is directed to the combination of a mat and a clip for retaining the mat substantially stationary on an underlying carpet. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A clip in combination with a mat having at least one aperture located therein for retaining said mat substantially stationary relative to an underlying carpet, said clip comprising:

means formed in an upper surface of said clip for receiving said peripheral edge of said mat;

means disposed on a lower portion of said clip and laterally adjacent said receiving means for engaging said aperture of said mat; and

means interconnected with said receiving means for anchoring said clip to said underlying carpet;

wherein said peripheral edge of said mat is juxtaposed said receiving means so as to align and engage said aperture of said mat with said engaging means.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Lundberg *et al.* (Lundberg)	2,137,652	Nov. 22, 1938
Dichtel	4,860,402	Aug. 29, 1989
Gilmore *et al.* (Gilmore)	5,186,517	Feb. 16, 1993

THE REJECTIONS

Claims 1 through 10, 12 through 15, 22, 24 and 26 stand rejected under 35 U.S.C. §103 as being unpatentable over Dichtel in view of Lundberg.

Claims 23 and 25 stand rejected under 35 U.S.C. §103 as being unpatentable over Dichtel in view of Lundberg and Gilmore.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

The objective of the claimed invention is to provide a structurally uncomplicated means for capturing a mat and securing it in place upon a carpet. As manifested in claim 1, the

invention comprises a mat having an aperture and a clip which comprises three elements:

(1) Means formed in an upper surface for receiving the peripheral edge of the mat.

(2) Means disposed on a lower portion of the clip and laterally adjacent the receiving means for engaging the aperture of the mat.

(3) Means interconnected with the receiving means for anchoring the clip to the underlying carpet.

It is the examiner's position that the subject matter of claim 1 would have been obvious to one of ordinary skill in the art in view of the teachings of Dichtel and Lundberg.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); *In re Rinehart*,

531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Dichtel is directed to a clip for securing a mat to an underlying carpet, and is presented in the appellant's specification as the "jumping off" point for his present invention. The reference is discussed on pages 2 and 3 of the specification, concluding with the observation that the clip disclosed therein might not be suitable for use with thin mats or with mats having particular surface characteristics, since it depends upon the interaction between pointed teeth and the upper surface of the mat for its operation. The Dichtel clip, like the clip set out in claim 1, comprises means (curved portion 50) formed in the upper surface for receiving a peripheral edge of the mat, and means (prongs 34a and 34b) interconnected with the receiving means for anchoring the clip to the underlying carpet

(56). Dichtel also provides means for holding the mat against movement away from the receiving means, in the form of a plurality of downwardly and forwardly oriented teeth (46) which are pressed into the upper surface of the mat. Thus, the mat is prevented from moving in one direction by engagement with the upwardly curved portion (50) of the clip, and from moving in the opposite direction by the teeth (46). As recognized by the examiner, Dichtel does not disclose providing the mat with an aperture or the clip with means disposed on a lower portion to engage the aperture.

The examiner looks to Lundberg for this teaching, concluding that it would have provided suggestion to one of ordinary skill in the art to modify the Dichtel clip so that it would meet the terms of the claim. We do not agree, for the reasons that follow.

Lundberg is directed to anchoring trim panels or the like to the underlying structure of a vehicle. It teaches providing the trim panel backing sheet (30) with an aperture (34), and then utilizing a clip which is fastened to the panel by tightly

engaging the aperture with a pair of oppositely oriented shoulders (21 and 29) which are mounted on a section of a spring clip which protrudes downwardly from the body of the clip (as illustrated in Figures 3 and 4). The upper portion of the clip is equipped with a spring bow (24, 25) which engages the vehicle structure.

To modify the Dichtel mat and clip in the manner proposed by the examiner would require a wholesale reworking of the Dichtel system. The previously un-apertured mat would have to be provided with an aperture, and the downwardly facing teeth on the upper portion of the spring loop would have to be discarded in favor of an upwardly facing element mounted on the lower portion of the clip. Even assuming, *arguendo*, that Lundberg constitutes analogous art, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to make these modifications. We first note here that the problem of securing the mat against movement in opposite directions has already been solved by Dichtel, and thus this factor would provide no incentive to modify. Second,

in the system disclosed by Lundberg the aperture is not in the panel received within the loop spring portion of the clip, but is in the element beneath the clip, which would correspond to the carpet in the Dichtel invention. Thus, this reference does not teach means disposed on the lower portion of the clip for engaging an aperture that is located within the spring portion of the clip, that is, above the lower portion, as is required by claim 1. From our perspective, one of ordinary skill in the art would have been taught by Lundberg, at best, to provide an aperture in the carpet, and not in the mat.

As our reviewing court stated in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992):

> It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" (citations omitted).

It is our view that the only suggestion for combining the references in the manner proposed by the examiner is found in the hindsight accorded one who first viewed the appellant's

disclosure. This being the case, we will not sustain the rejection of independent claim 1.

Independent claim 9 defines the invention in somewhat different terms, but still contains limitations which are not rendered obvious by the teachings of Dichtel and Lundberg, for the same reasons as were discussed above. The rejection of claim 9 also is not sustained.

The deficiencies in the basic combination of references are not cured by Gilmore, which was applied along with the others to claims 23 and 25.

The rejection of claims 1 through 10, 12 through 15, 22, 24 and 26 as being unpatentable over Dichtel in view of Lundberg is not sustained.

The rejection of claims 23 and 25 as being unpatentable over Dichtel in view of Lundberg and Gilmore is not sustained.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge)
)
)
)
JAMES M. MEISTER) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
)
NEAL E. ABRAMS)
Administrative Patent Judge)

Appeal No. 96-1868
Application No. 08/179,443

Remy J. Van Ophem
755 W. Big Beaver, Suite 1313
Troy, Michigan 48084